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09/972,424	10/04/2001	Chris E. Matichuk	03-509-A	8244
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MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP			EXAMINER	
300 S. WACKER DRIVE			CHOWDHURY, AZIZUL Q	
32ND FLOOR				
CHICAGO, IL 60606			ART UNIT	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/972,424	<b>Applicant(s)</b> MATICHUK ET AL.
	<b>Examiner</b> AZIZUL CHAUDHURY	<b>Art Unit</b> 2453

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 05 April 2011.  
 2a) This action is **FINAL**.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 41-80 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 41-80 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449)  
 Paper No(s)/Mail Date 4/14/2011

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date: \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

***Detailed Action***

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 5, 2011 has been entered.

The latest amendment features new claims 41-80 wherein previous claims 1-40 are now cancelled.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 74-80 are rejected under 35 U.S.C. 101 because based upon consideration of all of the relevant factors with respect to the claim as a whole, claim(s) 74-80 are held to claim an abstract idea, and is/are therefore rejected as ineligible subject matter under 35 U.S.C. 101. The rationale for this finding is explained below:

Claims 76-80 are directed towards computer readable mediums having instructions stored thereon. While claims 76-80 cite within the preamble that the computer readable medium stores, the office does not recognize such language as

limiting the computer readable medium to solely statutory forms. It would be beneficial instead to clarify the computer readable medium both as storing and as being "non-transitory" since, such a medium is deemed statutory (where supported by the specifications). As they currently stand though, the claims 76-80 are deemed non-statutory.

Claims 74-75 are directed towards system claims with no definitive structure. As claimed, the preamble states the invention is directed towards a system however, the body of the claims fail to support any definitive hardware. Instead, the claims describe an invention without any positive recitation of structure. This lack of structure fails to categorize the claimed inventions into a statutory category. As such, claims 74-75 are also deemed non-statutory.

On the other hand, claims 41-73 are deemed statutory and are not subject to the 101 rejection. These claims are directed towards a method which inherently would require a processor (structure) for proper operation. Structural inherency is applicable only to method type claims. Applicant may wish to review Federal Register, Volume 75, No. 143, July 27, 2010; particularly p. 43927, the section pertaining to "Factors Weighing Toward Eligibility" and "Factors Weighing Against Eligibility" for guidance, especially with regards to method claims.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 41-80 are rejected under 35 U.S.C. 102(e) as being anticipated by Franco (US PGPub No: 2002/0046407), hereafter referred to as Franco.

1. With regards to claims 41 and 76 Franco teaches, a method of programming a media-based device over a network, the method comprising: displaying information for a broadcast program on a first website using a client, wherein the information comprises a link (*Franco teaches the user having (television) programming listing or the programming information, the listing can be via a website; see paragraphs 13, 19, 24 and 28, Franco*); receiving a selection of the link using the client (*Franco teaches the user selecting content to be recorded; see paragraphs 13 and 28, Franco*); and in response to the selection of the link, generating a command including the information for the broadcast program and information about the media-based device (*Franco teaches transmitting a programming instruction (generating and sending a command) to the recording device; see paragraphs 14, 67 and 88, Franco*); sending the command to a

server (*see paragraphs 14, 67 and 88, Franco*); and the server processing the command to program the media-based device to record the broadcast program (*Franco teaches the video recording device recording the show based on the programming instruction sent by a host/server; see paragraphs 14-15 and 67, Franco*).

2. With regards to claim 42, Franco teaches the method wherein the information about the media-based device comprises a unit serial number for the media-based device (*see paragraphs 15 and 82, Franco*).
3. With regards to claims 43, 61, 66 and 71, Franco teaches the method wherein the selection of the link utilizes one click on the link (*see at least paragraphs 13, 24, 28 and 130 (one-click), Franco*).
4. With regards to claim 44, Franco teaches the method further comprising: allowing a second website to monitor a count of a number of times the link is selected; and enabling the second website to periodically collect revenue from the first website based on the count (*see paragraphs 95, 99, 126 and 153*).
5. With regards to claim 45, Franco teaches the method wherein the revenue comprises a percentage of advertising revenue associated with the information about the broadcast program (*Implicit that DoubleClick gets revenue percentage*;

*see paragraph 133, Franco).*

6. With regards to claim 46, Franco teaches the method wherein the media-based device comprises a video replay system (*see paragraph 67, Franco*).
7. With regards to claim 47, Franco teaches the method wherein processing selection of the advertisement comprises: identifying a user selecting the link; and authenticating the user (*Implicit that DoubleClick gets revenue percentage; see paragraph 133, Franco*).
8. With regards to claim 48, Franco teaches the method wherein identifying the user selecting the link comprises: identifying a cookie associated with the user; and enabling the cookie to be forwarded to the media-based device (*see paragraphs 27 and 129, Franco*).
9. With regards to claim 49, Franco teaches the method wherein the cookie is extracted from the client (*see paragraphs 27-29, 84 and 129-130, Franco*).
10. With regards to claim 50, Franco teaches the method wherein the cookie is extracted from a computer hosting the first website (*see paragraphs 27-29, 84 and 129-130, Franco*).

11. With regards to claim 51, Franco teaches the method wherein identifying the user selecting the link comprises: enabling linking of the first website to a second website; allowing navigation to the second website; and in response, the second website prompting for identification data (*Franco teaches the user selecting the content to record, and then at a second site authenticating the user; see paragraph 85, Franco*).
12. With regards to claim 52, Franco teaches the method wherein identifying the user selecting the link comprises: enabling determination of partner identification information associated with the first website (*see paragraphs 85 and 133 (DoubleClick is a partner), Franco*).
13. With regards to claim 53, Franco teaches the method wherein processing the command to program the media-based device to record the broadcast program comprises: enabling determination of a user associated with the media-based device; allowing navigation from the first website to a second website; and allowing the user to log into the second website (*see paragraphs 68 and 85, Franco*).
14. With regards to claim 54, Franco teaches the method wherein processing the command to program the media-based device to record the broadcast program comprises further comprises: detecting whether the selection had been made

previously (*see paragraphs 129 and 133, Franco*).

15. With regards to claim 55, Franco teaches the method wherein the information about the broadcast program comprises a clickable online advertisement for the broadcast program (*see paragraphs 28 and 131, Franco*).
16. With regards to claim 56, Franco teaches the method wherein the broadcast program comprises a television program (*see paragraphs 13 and 15, Franco*).
17. With regards to claim 57, Franco teaches the method wherein the broadcast program comprises a cable program (*see paragraph 65, Franco*).
18. With regards to claim 58, Franco teaches the method wherein the broadcast program comprises a pay-per-view program (*see paragraph 95, Franco*).
19. With regards to claim 59, Franco teaches the method wherein the broadcast program comprises a satellite-based program (*see paragraph 65, Franco*).
20. With regards to claims 60, 65 and 78, Franco teaches a method of programming a media-based device to record content through a web-based application, comprising: receiving a selection of a broadcast program (*Franco teaches the user selecting content to be recorded; see paragraphs 13 and 28, Franco*);

extracting identification information associated with the media-based device and with the broadcast program (*see paragraphs 17-18 and 25, Franco*); generating a command based on the information associated with the media-based device and with the broadcast program; sending the command to a source web service (*Franco teaches transmitting a programming instruction (generating and sending a command) to the recording device; see paragraphs 14, 67 and 88, Franco*); and the source web service processing the command to program the media-based device to record the broadcast program (*Franco teaches the video recording device recording the show based on the programming instruction sent by a host/server; see paragraphs 14-15 and 67, Franco*).

21. With regards to claims 62, 67, 72 and 80, Franco teaches the method wherein receiving the selection of the broadcast program comprises receiving the selection via a clickable online advertisement for the broadcast program (*see paragraphs 28 and 133, Franco*).
22. With regards to claims 63 and 68, Franco teaches the method further comprising: collecting revenue based on the selection (*Implicit that DoubleClick gets revenue percentage; see paragraph 133, Franco*).

23. With regards to claims 64, 69, 73, 75, 77, and 79, Franco teaches the method wherein the media-based device comprises a digital video recorder (*see paragraph 67, Franco*).

24. With regards to claim 70, Franco teaches a method for programming a media-based device, comprising: receiving a command at a server, the command comprising information about the media-based device, and information for a user (*Franco teaches the user selecting content to be recorded along with user information; see paragraphs 13, 27 and 28, Franco*); and the server processing the command at least to: (i) authenticate the user based on the information for the user (*Franco teaches authenticating the user; see paragraphs 27 and 68, Franco*) and (ii) program the media-based device based on the information about the media-based device (*Franco teaches the video recording device recording the show based on the programming instruction sent by a host/server; see paragraphs 14-15 and 67, Franco*).

25. With regards to claim 74, Franco teaches a system, comprising: a client side system enabled to allow selection of a link for a broadcast program (*Franco teaches the user selecting content to be recorded along with user information; see paragraphs 13, 27 and 28, Franco*), and a server side system enabled to process a command generated in response to the selection to program a media-based device to record the broadcast program, wherein the command comprises

information for the broadcast program and information about the media-based device (*Franco teaches the video recording device recording the show based on the programming instruction sent by a host/server; see paragraphs 14-15 and 67, Franco*).

***Response to Arguments***

Applicant's arguments with respect to claims 41-80 have been considered but are moot in view of the new ground(s) of rejection. In lieu of the latest claim amendments, a new search was performed and the Franco prior art has been applied. Franco teaches a web-based host system which enables users to remotely program a recording device to record a broadcast program.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AZIZUL CHOUDHURY whose telephone number is (571)272-3909. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Krista Zele can be reached on (571) 272-7288. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. C./  
Examiner, Art Unit 2453

/Krista M. Zele/  
Supervisory Patent Examiner, Art Unit 2453